

REMARKS

This amendment is in response to the Office Action mailed June 22, 2004. Claims 1-15 were pending, and the Office Action rejected all claims. Certain objections to the specification and claims were raised based on the use of the term "input transistor" in the claims. This term has been dropped in the newly drafted claims, and therefore the applicants believe that the § 112 rejections have been addressed. Apparently, only Claims 1-7 and 11 were rejected in view of prior art, and Claims 8-10 and 12-15 would be allowable if rewritten to overcome the § 112 rejections. The applicants have cancelled original Claims 1 – 15 and have generally rewritten them as Claims 16 – 28, with various modifications. It is believed that these claims are in now in condition for allowance for the reasons discussed below.

Certain claims were rejected under 35 U.S.C. § 103(a) in view of various prior art references. It is the applicants' view that the combination of the references as suggested by the Examiner would not have been obvious to one of skill in the art without using the present specification as a guide. Such "hind-sight" reconstruction is improper. For example, in order to reject prior claim 7, the Office Action requires the combination of four other references. It is respectfully submitted that the combination of four separate references can rarely, if ever, support an obviousness rejection. As stated in *Ex parte Hiyamizu*, 10 USPQ 2d 1393, 1394-95 (BPAI 1988), "Under 35 U.S.C. § 103 where the examiner has relied on the teachings of several references, the test is whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. It is to be noted, however, that citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious."

In the present case, the stated rejection merely point out that various parts or elements of the present invention may be found in other references. This is an insufficient basis to prove that the specific combination of elements as disclosed in the present application would have been obvious to one of skill in the art.

Moreover, the cited references include many elements in differing combinations which are NOT found in the present application. Only by referencing the present invention can the Examiner determine which elements to include and which to exclude. Such an exercise does not support an obviousness rejection and is improper. As stated in *Akzo N.V. v. United States International Trade Commission*, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987), “Prior art references. . . . must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. . . . Moreover, appellants cannot pick and choose among individual parts of assorted prior art references ‘as a mosaic to recreate a facsimile of the claimed invention’”.

In the present rejection, the Examiner has not considered how the specific references teach away from the present invention i.e. by teaching different circuits having different combination of elements. In fact, it is not clear that any of the hypothetical combinations proposed by the Examiner would even function. Specifically, the Office Action cites a combination of Fowler and Ueno as teaching a circuit having a feed-back enhanced reset amplifier, a high-gain amplifier connected to a photodetector, and an adaptive skimming circuit with an integration capacitor. With all due respect, the Office Action merely uses the applicants' claims as a guide to select various components from the prior art, without any consideration whether the circuits of Fowler and Ueno could, in fact, be combined.

For the foregoing reasons, it is respectfully submitted that the present claims are allowable over the cited prior art of record.

The Commissioner is hereby authorized to charge any fees (or credit any overpayment) associated with this communication and which may be required under 37 CFR §1.78 to Deposit Account No. 50-2603, referencing Attorney Docket No. 354096.00300. A duplicate sheet is attached.

Respectfully submitted,

REED SMITH LLP

Dated: September 15, 2004

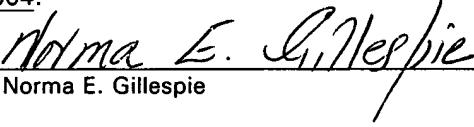
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, US Patent & Trademark Office, P.O. Box 1450 Alexandria, VA 22313 on September 15, 2004.

Dated: September 15, 2004


Norma E. Gillespie